THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WELL MADE TOY MANUFACTURING CORP.

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Appeal No. 98-3120
Reexamination Proceeding: 90/003,638[1]

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ON BRIEF

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Before THOMAS, FLEMING, and CARMICHAEL, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 4, which are all of the pending

[1] Request for reexamination filed November 15, 1994 for reexamination of U.S. Patent 4,630,301, issued December 16, 1986, based on Application 06/741,286, filed June 4, 1985.

claims in the above-identified reexamination of United States patent 4,630,301. The claimed subject matter is directed to an electronic circuit for use in a toy for recording into dynamic random access memory speech during a record interval and then automatically initiating a playback interval at the end of the record interval to play back the spoken words. Thus, the toy is able to record the user voice for a fixed interval and then automatically echo the user's spoken words during the fixed interval back to the user.

Independent claim 1 is reproduced as follows:

1. A voice-activated echo generator circuit for use in an electronic toy comprising:

(a) microphone means for producing an analog audio signal in response to sound received thereby

(b) threshold detection means responsive to said analog audio signal for initiating a record/playback cycle, said record/playback cycle comprising a distinct record interval automatically followed by a distinct playback interval,

(c) means, active during said record interval, for digitally coding said analog audio signal received during said record interval,

(d) memory means for storing said digitally coded audio signal formed during said record interval,

(e) means for automatically initiating said playback interval at the end of said record interval,

(f) means active during said playback interval, for reading said digitally coded audio signal out of said memory means and for decoding said digitally coded audio signal back into analog audio form, and

(g) loudspeaker means for broadcasting said analog audio signal to provide an automatic echo of said received sound.

The references relied on by the Examiner are as follows:

Lee	3,469,039	Sep. 23, 1969
Katz	4,528,689 (filed Dec. 7, 1983)	Jul. 9, 1985

Pollock et al. (Pollock), "A Solid State Delayed Auditory Feedback System for Speech Therapy," ***Biomedical Engineering***, vol. 11, no. 26, pp. 413-14 (Dec. 12, 1976)

Claims 1 through 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lee, Pollock and Katz.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs[2] and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we will sustain the Examiner's rejection of claims 1 through 4 under 35 U.S.C. § 103.

At the outset, we note that Appellant has indicated on page 4 of the brief the groupings of the claims. In particular, Appellant states that claims 1, 2 and 4 are separately patentable. However, we note that Appellant has only argued claim 1. 37 CFR § 1.192(c)(7) (July 1, 1996) ***as amended at*** 60 Fed. Reg. 14518 (March 17, 1995), which was

[2] Appellant filed an appeal brief on July 29, 1996. We will refer to this appeal brief as simply the brief. Appellant filed a reply appeal brief on March 24, 1997. We will refer to this reply appeal brief as the reply brief. A Decision on Petition, mailed August 31, 1998 stated that the reply brief will be entered and considered but there is no further response by the Examiner. We will treat the reply brief as entered and properly before us for our consideration.

controlling at the time of Appellant's filing the brief, states:

> For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appellant has not provided an explanation of why claims 2 and 4 are separately patentable other than merely pointing out differences in what these claims cover. We will, thereby, consider the Appellant's claims as standing or falling together and we will treat claim 1 as a representative claim of the group, claims 1 through 4.

Scope of Appellant's claim 1

Appellant points out on page 2 of the reply brief that Appellant's claim 1 recites a means for "automatically initiating said playback interval at the end of said record interval." Appellant states on pages 2 and 3 of the reply brief that "the circuit components as well as the described multiplexing and control techniques described in the specification to perform the function of the 'means' clauses in claims 1 and 2 (or their equivalent) are, by statute, part of the subject matter defined in these claims. However, we note that Appellant did not point to specific portions of the specification or to specific structure shown in the drawings of the patent that disclose this structure. Furthermore, Appellant did not address what is the equivalent of this structure.

"[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). "Analysis begins with a key legal question--***what*** is the invention ***claimed***? . . . Claim interpretation . . . will normally control the remainder of the decisional process." ***Panduit Corp. v. Dennison Mfg. Co.***, 810 F.2d 1561,

1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), ***cert. denied***, 481 U.S. 1052 (1987). Furthermore, our reviewing court states in ***In re Donaldson Co.***, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) that the "plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure."

In column 2, lines 7-53, Appellant's patent discloses that two counters 20 and 21 generate the record and playback timing for the memory 16. In column 2, lines 20-32, Appellant's patent discloses that row address of memory 16 is formed by bits Q4-Q11 of counter 20 and the column address of memory 16 is formed by bits Q12 and the low-order seven bits of counter 21 and the row and column addresses from counters 20 and 21 are multiplexed onto the address bus of the memory 16. In column 2, lines 33-53, Appellant's patent discloses that when the bits Q8 and Q9 of counter 21 are set, a signal

is outputted from counter 21 to cause the termination of the record cycle and the commencement of the playback cycle.

From this disclosure, we find that the counter 21 is the corresponding structure for the "means for automatically initiating said playback interval at the end of said record interval" as recited in Appellant's claim 1. However, we also note that a microcomputer programmed to count to initiate a playback interval is equivalent structure to a counter such as disclosed by Appellant's patent. Therefore, we find that the scope of Appellant's claim 1 includes both a counter for automatically initiating the playback interval at the end of the record interval as well as an equivalent structure of a microcomputer programmed for automatically initiating the playback interval at the end of the record interval.

Prima Facie Case

On page 6 of the brief, Appellant admits that Lee cycles automatically with the only outside input or control being the spoken work as define in the claims of the patent. We note that Lee teaches in column 1, lines 55-60 that the

receipt of a sound signal automatically initiates two consecutive complete cycle of the endless tape, the first being a recording cycle and the second a reproducing cycle, the entire operation being automatically effected without any outside influence other that the initial human vocalization, itself.

Appellant argues on pages 6-8 of the brief that Lee teaches a different structure for providing the automatic initiating of the playback interval at the end of the record interval. We agree that Lee does not teach a counter ***per se*** for providing the automatic initiating of the playback interval. Appellant further argues on page 11- 14 that Pollock fails to teach initiating a record/playback cycle. Finally, on
pages 14-18 of the brief and in the reply brief, Appellant argues that Katz fails to teach automatic cycling function as required by claim 1.

However, the Examiner did not rely on Lee, Pollock or Katz individually but relied on what the combination of the teachings of Lee, Pollock and Katz as a whole would have

taught to those skilled in the art. The Federal Circuit reasons in ***Para-Ordnance Mfg. Inc. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), ***cert. denied***, 117 S. Ct. 80 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellant.

The Examiner has shown that Lee teaches a voice-activated echo generator circuit for use in an electronic toy that provides all of the means as claimed except that Lee teaches analog structure which uses a tape loop. The Examiner has shown that Pollock teaches to those skilled in the art that there are advantageous reasons to redesign or upgrade an analog echo generator circuit that operates using a tape loop to use solid digital state electronics including a digital memory. In particular, Pollock teaches in the third column from the right on the first page that digital solid state electronics provides advantages of no moving parts, low cost

and simplicity of operation. Thus, Pollock teaches to those skilled in the art that one should solve the problem using digital solid state electronics. Having the Lee analog structure teachings and the Pollock teaching of reasons to redesign or upgrade such analog structures to a digital solid state electronic structure, the Examiner points out that one skilled in the art had an additional teaching, Katz, before him in his prior art workshop.

Katz teaches the solution of the problem by providing a digital solid state electronic device, a microcomputer having a memory. In particular, Katz teaches in column 3, lines 54-68, that Figure 2 is a block diagram of a digital solid state electronic apparatus having a memory and central processing unit that is able to digitally record sound in a digital memory and play back the sound from the digital memory. The Examiner argues that it would have been obvious to program the Katz digital solid state electronic apparatus having a memory and central processing unit to provide the functions taught by Lee for the reasons taught by Pollock.

Appellant argues on pages 2 and 3 of the reply brief that Katz does not have a distinct record interval which is separate from a distinct playback interval. However, we find that the combination of Lee, Pollock and Katz does teach a means for automatically initiating the playback interval at the end of the record interval as recited in Appellant's claim 1. We noted above that Lee does teach such a means. Furthermore, we find that it was reasonably expected for those skilled in the art to have used the solution that is claimed by the Appellant. In particular, having Pollock’s teaching that it was advantageous to redesign or upgrade endless tape loop systems to use digital solid state electronics, and the Katz teachings of a microcomputer which is able to record and playback sound, it would have been obvious to those skilled in the art to program the Katz microcomputer to provide the automatic playback interval as taught by Lee. Thus, from the teachings of Pollock and Katz, it would have been within the skill of those skilled in the art to program Katz's microcomputer to provide Lee's automatically initiated playback interval at the end of the record interval so as to

redesign the Lee analog echo generator circuit to use solid state digital electronics that in turn uses a computer or digital memory as recited in Appellant's claim 1. Furthermore, Pollard would have given the specific reasons to those skilled in the art to do such a redesign of the Lee analog apparatus.

Appellant also argues on pages 2 and 3 of the reply brief that the means must be construed to cover the corresponding structure and its equivalents as disclosed in the Appellant's specification. As point out above, we have found that the scope of Appellant's claim 1 includes a microcomputer programmed for automatically initiating the playback interval at the end of the record interval. Therefore, the combination of Lee, Pollock and Katz would have taught those skilled in the art to provide a microcomputer programmed for automatically initiating the playback interval at the end of the record interval. As we have previously found, a microcomputer programmed for automatically initiating the playback interval upon a certain count was equivalent structure to a counter, and thereby meets the limitations

recited in Appellant's claim 1. Therefore, we find that it would have been obvious to those skilled in the art in view of the teachings of Lee, Pollock and Katz to provide a voice-activated echo generator circuit as recited in Appellant's claim 1.

Appellant has chosen not to argue any other of the specific limitations of the claims as a basis for patentability. We are not required to raise and/or consider such issues. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR § 1.192 (a)(July 1, 1996) ***as amended at*** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellant's filing the brief, states:

> The brief . . . must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration

> by the Board of patent Appeals and Interferences, unless good cause is shown.

Also, 37 CFR § 1.192(c)(8)(iv) states:

> For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that this board is not under any greater burden than the court to raise and/or consider such unargued issues.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JAMES T. CARMICHAEL Administrative Patent Judge	)

Appeal No. 98-3120
Reexamination Number 90/003,638

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